

REMARKS

The present amendment is responsive to the Office Action mailed in the above-referenced case on January 08, 2008.

Rejection under 35 U.S.C. 112

Claims 50-58 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement.

Examiner's rejection

The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

A. The only disclosure of placement of the corrosion-protection prior to joining of two metal parts, in the originally-filed disclosure, is at 9:23ff. of the specification, concerning only a MacPherson strut with spot welds.

B. Consequently, the originally-filed disclosure fails to support the any and all types of metal parts and means of joining encompassed by the claim language.

Applicant's response

Applicant herein cancels claims 50-67 and presents new claims 69-76 for examination. Applicant believes the newly written claims are well supported in applicant's specification which will be clearly demonstrated below in applicant's response to the merit rejections.

Additionally, applicant points out that the Examiner is mistaken stating that; “The only disclosure of placement of the corrosion-protection prior to joining of two metal parts, in the originally-filed disclosure, is at 9:23ff. of the specification, concerning only a MacPherson strut with spot welds.” This is simply not true. Applicant’s specification describes the MacPherson Strut application in detail, and the remaining embodiments, beginning on page 10, clearly recite (emphasis added); “Figures 5A to 7 show, again as a schematic, sketch-like drawing, another case of application of the **proposed method and structural element**, involving a section of an automobile roof 17 with underlying roof bow 19...” (page 10, 18-20). Clearly the other embodiments merely alter the type of parts and shape of the carrier, as presented in the initially proposed embodiment, but the procedure of assembling the parts is maintained as proposed in the embodiment including the MacPherson strut.

Merit rejection under 35 U.S.C. 102(b)

Claims 59-67 are rejected under 35 U.S.C. 102(b) as being anticipated by Cleslik (EP 0 453 777 A2). A. These claims are rejected for the same reasons as set forth in the prior Office action and as explained above.

Applicant’s response

Applicant herein presents three independent method claims 69, 72 and 75 to particularly recite methods of corrosion protection incorporating a unique carrier device (13, 13’, 13’’, 23, 23’, door-carrier module 27) not previously known in the art.

Newly presented claim 69 recites a method for providing corrosion protection in assembly of two or more metal parts, at least one of which is made of sheet metal, and which are joined in a fashion leaving a space between the parts by forming a rigid and thermally stable carrier having a groove therein for engaging an edge region of the at least one sheet metal part, and firmly attaching to the thermally-stable carrier a thermally-foamable element, such that the thermally-foamable element, with the thermally-stable carrier engaging the edge region of the at least one sheet metal part, and the parts joined,

is disposed in the space between the parts. The assembly is then exposed to heat sufficient to foam the thermally-foamable element to seal between the parts.

Applicant's specification clearly teaches what is recited in claim 69, as follows:

"Figure 5B shows how in one embodiment of the invention there is disposed between roof and roof bow a lining element 21 that comprises a thermally stable carrier 23 and a thermally-foamable section 25.

The t-stable carrier 23 can in particular consist of a polyamide, where appropriate with fibre reinforcement and/or a proportion of recycled materials, and its shape is adapted to the configuration of the edge region of the roof bow 19 in such a way that it can be snapped or clipped onto the latter, and by virtue of its elasticity in both material and shape is reliably fixed there for the duration of the procedure. To a section 23a that projects from the side of the carrier profile is attached the EVA section 25, which is approximately rectangular in cross section and in Fig. 5B is shown in the non-expanded state. In the expanded state it fills up the space between the roof 17 and the roof bow 19 in a flexible but moisture-proof manner, and hence both provides additional protection against corrosion for this cavity and also serves as an under-roof lining with advantageous mechanical properties." (page 9, line 26 to pg. 10, line 12)

Applicant argues that Clesik fails to teach or suggest applicant's claimed carrier. Clesik teaches a sealant plug inserted into an aperture after assembly. The plug is used with a retainer cap to keep the sealant material from expanding through the insertion hole when heat is applied.

Independent claims 72 and 75 also claim the carrier, as argued, therefore, the newly presented claims are easily patentable over Clesik.

10. Claims 50-52, 56, 57, 59, 60, 61, 65, and 66, are rejected under 35 U.S.C. 102(b) as being anticipated by Nakazato et al. (EP 0 775 721 A1).

Examiner's rejection

- A.** Nakazato teaches the claimed process at 4:21-41 and illustrated in Fig. 3.
- B.** With specific respect to claims 52 and 61, it is the Examiner's position that the adhesive layer that holds the heat-expandable sheet in place anticipates these claims.
- C.** With specific respect to claims 56, 57, 65, and 66, the electro-deposition and subsequent coating with associated baking that includes foaming, anticipates the limitations of these claims.

Applicant's response

Applicant points out that Nakazato clearly teaches bonding the expandable material directly to the metal part via spot welds or epoxy. Therefore the new claims are easily patentable over Nakazato.

11. Claims 50-52, 55-57, 59-61, and 64-66, are rejected under 35 U.S.C. 102(b) as being anticipated by Sorderberg (EP 0 383 498 A2).

Examiner's rejection

- A.** Sorderberg teaches the claimed process at 5:5-30.

Applicant's response

Page 5, lines 5-30 of Sorderberg teaches; "With reference to the figure an inner pillar part 2 is secured by metal bolts or other fasteners 14 to an outer pillar part 4 in the course of assembly. A shield 6 is provided inside the pillar. Prior to assembly an insert of the composition of the invention 8 is secured by a stud 10 and optional washer 12 to the inner pillar part 2 so that, after assembly, the insert is clear of all surrounding walls.

Applicant points out that the stud 10 of Sorderberg is not formed to *engage* the thermally-foamable element, as claimed. Therefore, Sorderberg also fails to read in applicant's claimed carrier.

Summary

Applicant also believes the rejections presented by the Examiner in items 13 and 14 are moot in view of the newly presented claims, as argued above. Applicant's new independent method claims 69, 72, and 75 have been adequately shown to be patentable over all of the art presented by the Examiner. Dependent claims 70-71, 73-74 and 76 are therefore patentable on their own merits, or at least as depended from a patentable claim.

As all of the claims have been shown to be patentable over the art, applicant respectfully requests reconsideration and the case be quickly passed to issue. If there are any time extensions due beyond any extension requested and paid with this amendment, such extensions are hereby requested. If there are any fees due beyond any fees paid with the present amendment, such fees are authorized to be deducted from deposit account 50-0534.

Respectfully Submitted,
Reinhard List

By **/Donald R. Boys/**
Donald R. Boys
Reg. No. 35,074

Central Coast Patent Agency, Inc.
3 Hangar Way, Suite D
Watsonville, CA 95076
831-768-1755